



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPELLANT: Petkovesk

EXAMINER: Borissov

SERIAL NO.: 09/784,479

GROUP ART UNIT: 3639

FILING DATE: February 15, 20001

ATTY. DKT. NO.: USA-P-01-001

INVENTION: "A SYSTEM AND METHOD FOR AUTOMATING DELIVERY  
COMMUNICATION BY SPECIAL SERVICE"

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANT'S TRANSMITTAL**

SIR:

Appellant submits herewith Appellant's Reply Brief in response to the Examiner's Answer dated July 25, 2006.

Appellant submits that no fee is required for submission of this Reply Brief. However, the Commissioner is hereby authorized to charge any fees which may be required, or to credit any overpayment to Deposit Acct. No. 50-0595. A duplicate of this sheet is enclosed for this purpose.

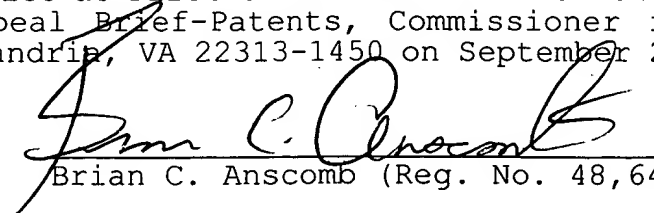
Respectfully submitted,

  
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**CERTIFICATE OF MAILING**

I hereby certify that this **REPLY BRIEF** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 25, 2006.

  
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**APPELLANT'S REPLY BRIEF**

S I R:

This Reply Brief is submitted in response to the Examiner's  
Answer dated July 25, 2006.

# **I. STATUS OF CLAIMS**

Claims 1-18 are pending in this patent application. Claims 1-18 were finally rejected by the Examiner in a Final Rejection dated June 22, 2005 and are hereby on appeal.

## **II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Would Claims 1-18 have been obvious under 35 U.S.C. §103(a) to one having skill in the art at the time of Appellant's invention over *Greco et al.* (U.S. Patent Application No. 2002/120680) in view of *Heston* (U.S. Patent Application No. 2002/0019741)?

### **III. ARGUMENT**

In the Examiner's Answer, new points of arguments were raised by the Examiner.

#### **A. THE CITED REFERENCES AND REJECTIONS OF CLAIM 1-18**

Independent Claims 1-18 stand rejected under 35 U.S.C. §103.

In the Examiner's Answer, the Examiner alleges:

Claim 1: *Greco et al.* teach a database accessible by the user; said database resides in said service provider server remotely from the user computer [0080]; wherein said database contains information regarding precessing and delivery of a document(communication) (for example legal documents Fig 5A; and the use of the document preparation software for creating said legal documents [0074]by appropriate Internet-base document-related services (special services0 [0012]-[0014]; [0051]; said appropriate special service are selected based on criteria/factors, said criteria/factors including: information type of service they provide, the user's location , he user's preference, financial or business considerations, etc. [0083] said database further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084].

Further, *Greco et al.* teach explicitly teach providing criteria regarding selection of special service appropriate for the delivery of the communication via graphical user interface, and storing requirements to effect the delivery of the communication by the special service.

*Greco et al.* teach that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site.

Claim 12: *Greco et al.* teach a database accessible by the user; said database resides in said service provider server remotely from

the user computer [0080]; wherein said database contains information regarding precessing and delivery of a document(communication) (for example legal documents Fig 5A; and the use of the document preparation software for creating said legal documents [0074]by appropriate Internet-base document-related services (special services0 [0012]-[0014]; [0051]; said appropriate special service are selected based on criteria/factors, said criteria/factors including: information type of service they provide, the user's location , he user's preference, financial or business considerations, etc. [0083] said database further includes delivery information and instructions [0089]; and identities of various service providers and links to web-sites of said various service providers [0084].

Greco et al. explicitly teach providing criteria regarding selection of special service appropriate for the delivery of the communication via a graphical user interface, and storing requirements to effect the delivery of the communications by special service.

The art teaches the step of automatically mailing the communication by the special service, generating fees and automatically paying the fees.

**B. CLAIMS 1-18 WOULD NOT HAVE BEEN OBVIOUS TO ONE OF ORDINARY SKILL IN THE ART AT THE TIME OF APPELLANT'S INVENTION IN VIEW OF GRECO ET AL. AND FURTHER IN VIEW OF HESTON, TAKEN SINGLY OR IN COMBINATION**

Independent Claim 1 requires a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service. Further, Claim 1 requires that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and is

automatically mailed by the special service via the computer accessible site.

Independent Claim 12 requires the steps of providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication. Further, Claim 12 requires the step of automatically mailing the communication by the special service, generating fees and automatically paying the fees.

Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests a database that stores the communication, stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication and stores requirements to effect the delivery of the communication by the special service, as required by Claim 1. Contrary to the assertions of the Examiner, *Greco et al.* merely teach:

[0014] The system includes a document preparation application and a graphical user interface. That document preparation application is configured to create a plurality of documents. The graphical user interface is integrated within the docent

preparation.

[0012] The graphical user interface is implemented with a document preparation application used to create the document. The graphical user interface includes instructions for contacting a server to identify available document services; instructions for contacting for contacting a plurality of graphical selectable objects based on the available document services, each of graphical selectable objects corresponding to one of the available document services; instructions for detection of one of the available document services based on selection of one of the graphical selectable objects; and instructions for providing the document from the document preparation application to one or more service providers for performance of the selected document service.

[0089] The server 120 may then interact with the user to collect the information necessary to provide the requested document service [Fig. 8; act 850]. For example, the document the user is currently viewing via the graphical user interface of the document preparation software 320 may be automatically, securely, and electronically provided to the server 120.

Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the step of providing criteria regarding selection of special service appropriate for the delivery of the communication via a graphical user interface, and storing requirements to effect the delivery of the communications by special service as required by the Claim 12. On the contrary, *Greco et al.* merely teach:

[0062] For example, the software buttons may include an E-Signature Service button 405, Overnight Courier Service button 410, E Mail Service Button 415, a Data Storage button 420, a Traditional Mail Service button 425, a Translation Service button 430, a Print and Copy room Service button 435, a Government



Filing Service button 440, a By Hand Delivery Service button 445, and Address Book Management Service button 450, and E Collaboration Service button 455, and various other document service button 460.

[0064] The overnight Courier Service button 410 may initiate overnight delivery of the document via a service courier service. This function may provide a price comparison for shipping options, payment via credit card or debit card, very late pickup times, and where legally permissible, the assignment of an earlier date to the receipt, transmission, or processing of the document (e.g. a document received, transmitted, or processed after midnight may be assigned a date of the previous day). The user may provide the document and delivery instructions electronically to a secure location of a service provider, which may include a courier service or service provider operating in partnership with a courier service. When the local service provider (e.g. , an east coast service provider) is closed, the document may automatically delivered to another service provider (e.g., west coast service provider) that is open. The service provider may print the document, put it in an envelope, and deliver it according to the user's instructions.

[0089] The server 120 may also obtain delivery information and instructions via a convenient form provided to the user. The form may provide to the user via a window, such as a browser window or pop-up window. The server 120 may then provide the requested document service for the user [act 860].

Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests that the communication is automatically prepared in compliance with the requirements of the delivery by the special service and automatically mailed by the special service via the computer accessible site as required by Claim 1. On the contrary to the assertions by the Examiner, *Greco*

*et al.* merely teach:

[0064] The overnight Courier Service button 410 may initiate overnight delivery of the document via a service courier service. This function may provide a price comparison for shipping options, payment via credit card or debit card, very late pickup times, and where legally permissible, the assignment of an earlier date to the receipt, transmission, or processing of the document (e.g. a document received, transmitted, or processed after midnight may be assigned a date of the previous day). The user may provide the document and delivery instructions electronically to a secure location of a service provider, which may include a courier service or service provider operating in partnership with a courier service. When the local service provider (e.g., an east coast service provider) is closed, the document may automatically delivered to another service provider (e.g., west coast service provider) that is open. The service provider may print the document, put it in an envelope, and deliver it according to the user's instructions.

Moreover, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the step of providing a database accessible by a user via the computer-accessible site that stores instructions to assist the user to completely prepare the communication, stores criteria regarding selection of the special service appropriate for the delivery of the communication, stores requirements to effect the delivery of the communication by the special service, stores the communication, and stores a directory of mailing addresses that is accessed to confirm an address of a recipient of the communication as required by Claim 12. On the contrary, *Greco et al.* merely teach:

[0014] the system includes a document preparation application and a graphical user interface. That document preparation application is configured to create a plurality of documents. The graphical user interface is integrated within the document preparation.

[0012] The graphical user interface is implemented with a document preparation application used to create the document. The graphical user interface includes instructions for contacting a server to identify available document services; instructions for contacting for contacting a plurality of graphical selectable objects based on the available document services, each of graphical selectable objects corresponding to one of the available document services; instructions for detection of one of the available document services based on selection of one of the graphical selectable objects; and instructions for providing the document from the document preparation application to one or more service providers for performance of the selected document service.

[0089] The server 120 may then interact with the user to collect the information necessary to provide the requested document service [Fig. 8; act 850]. For example, the document the user is currently viewing via the graphical user interface of the document preparation software 320 may be automatically, securely, and electronically provided to the server 120.

Furthermore, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests the steps of automatically mailing the communication by the special service, generating fees and automatically paying the fees as required by independent Claim 12. On the contrary, *Greco et al.* merely teach:

[0064] The user may provide the document and delivery instructions electronically to a secure location of a service provider, which

may include a courier service or a service provider (e.g. an east coast service provider) is closed, the document may be automatically delivered to another service provider a (e.g. a west coast service provider) that is open. The service provider may print the document, put it in an envelope, and deliver it according to the user's instructions.

[0097] The server may also consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g. monthly) bill to the user. The bill may itemize the various services a=to aid the user in identifying the costs.

[0064] The Overnight Courier Service button 410 may initiate overnight delivery of the document via a courier service. This function may provide a price comparison for shipping options, payment via credit or debit card.

Dependent Claim 5 requires a means for generating addresses for the delivery of information. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests a means for generating addresses necessary for the delivery of information as required by Claim 5. On the contrary, *Greco et al.* merely teach:

The Address Book management Service button 450 may initiate a function to manage personal and business information of a user. This function may provide a one-click importing of information relating to a recipient of a document. The function may interact with conventional address/contact book software on one or more devices.

Dependent Claim 7 requires a means for suggesting mailing requirements based on information input by the user. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests a means for suggesting mailing requirements based on information input by the user as required by Claim 7. *Greco et al.*

merely teach:

that in response to information inputted by the user via the graphical user interface, the system (the server 120) generates requirements/instructions for guiding the user through necessary steps to successfully achieve the desired by the user document service [0012].

Dependent Claim 8, requires a means for computing postage costs and fees to the user associated with the delivery by the special service, neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or even remotely suggests a means for computing postage costs and fees to the user associated with the delivery by the special service as required by Claim 8. Contrary to the assertions of the Examiner, *Greco et al.* merely teach:

[0097] The server 120 may also consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g. monthly) bill to the user. The bill may itemize the various services to aid the user in identifying the costs.

wherein the server 120 is said means for computing postage costs and fees to the user.

Dependent Claim 9 requires a means for contacting a supplier necessary to complete the delivery of the communication by the special service. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or even remotely suggests a means for contacting a supplier necessary to complete the delivery of the communication by the special services as required by Claim 9. *Greco et al.* merely teach:

Any of the functions offered through the toolbar may be offered on a direct basis through

the entity providing the system. Conversely, any of the functions offered through the toolbar may be provided in conjunction with established providers of the functions outside the system (e.g., FedEx, Kinko's, UPS, DHL, the U.S. Post Office, etc.)

Dependent Claim 13 requires the step of determining required services for the delivery by the special service and costs associated with the delivery. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests determining required services for the delivery by the special service and costs associated with the delivery as required by Claim 13. *Greco et al.* merely teach:

providing links to web-sites of the Internet-based document-related service providers [0084] based on information input by the user and client location information (e.g., city state, country) [0082]-[0084]. As per determining costs associated with the delivery, *Greco* teaches providing monthly bills to the user for special services rendered, said bills including itemization of services rendered to the user [0097].

Dependent Claim 14 requires the step of providing suggestions for complying with requests for delivery by the special service based on the demographics input by the user and the communications chosen by the user. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests providing suggestions for complying with requests for delivery by the special service based on the demographics input by the user and the communications chosen by the user as required by Claim 14. Contrary to the assertions of the Examiner, *Greco et al.* merely teach:

in response to the client request for a

special service providing links to web-sites of the Internet-based document -related service providers [0084] based on information input by the user and client location information (e.g. city, state, country) [0082]-[0084]; [0012], thereby indicating utilizing demographic information.

Dependant Claim 15 requires the step of generating the communication based on information input by the user. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests generating the communication based on information input by the user as required by Claim 15. *Greco et al.* merely teach:

a process of creating a document during which the client is presented (on-line) with a choice of legal documents to be created; then the client is presented with a form (template) for a selected document, into which the client enters necessary information such as name, address, etc. [0105].

Dependent Claim 17 requires the step of providing dates and times of steps taken by a special service mail provider in mailing the communication. Neither *Greco et al.* nor *Heston*, taken singly or in combination, teaches or suggests providing dates and times of steps taken by a special service mail provider in mailing the communication as required by Claim 17. Contrary to the Examiner's assertions, *Greco et al.* merely teach:

The server 120 may also consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g. monthly) bill to the user. The bill may itemize the various services to aid the user in identifying the costs.

Dependent Claim 18 requires the step of generating a report of actions taken by a special service mail provider. Neither *Greco et*

*al.* nor *Heston*, taken singly or in combination, teaches or suggests generating a report of actions taken by a special service mail provider as required by Claim 18. *Greco et al.* merely teach:

[0097] The server 120 may also consolidate the fees incurred for various document-related services requested by the user and provide a periodic (e.g. monthly) bill to the user. The bill may itemize the various services to aid the user in identifying the costs.

Moreover, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

A motivation to combine cannot be demonstrated by the fact that the references relate to the same field of endeavor. See e.g., *Ex Parte Murch, Roselle and Jones*, 2001 WL 1857258, Bd.Pat.App & Interf., Feb 06,2001). Therefore, *prima facie* obviousness has not been established by the Examiner as required under 35 U.S.C. §103. Accordingly, the rejection of Claims 2-11 and 13-18 under 35 U.S.C. §103(a) is improper.

Appellant further submits that the Examiner is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Appellant's system and method for assisting with preparation and mailing of a communication. However, hindsight reconstruction of Appellant's invention is impermissible. Therefore, Appellant respectfully submits that



Claim 11 distinctly defines the present invention from *Greco et al.* and/or *Heston*, taken singly or in combination.

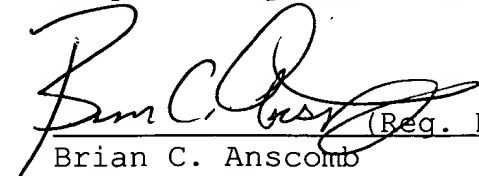
Even assuming that one having ordinary skill in the art could somehow have combined *Greco et al.* and *Heston* as set forth by the Examiner, the resultant combination still lacks the critical structural elements and novel steps positively recited in Claims 2-11 and 13-18, respectively.

In view of the foregoing, Appellant submits that the rejection of Claims 1 and 12 under 35 U.S.C. §103(a) is improper and should be reversed. Since Claims 2-11 set forth additional structural element of Appellant's system as defined by Claim 1, and Claims 13-18 set forth novel steps of Appellant's method as defined by Claim 12, the rejection of Claims 2-11 and 13-18 is improper and should be reversed.

#### IV. CONCLUSION


In view of the foregoing remarks, Appellant respectfully submits that all of the claims in the application are in allowable form and requests the Board to reverse the rejections of the Examiner.

Respectfully submitted,

  
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